



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,522	04/06/2005	Norbert Heske	289-PDD-03-08 US	6406
79990 7590 03/31/2009				
C. R. Bard, Inc. Bard Peripheral Vascular, Inc. 1415 W. 3rd Street P.O. Box 1740 Tempe, AZ 85280-1740				
EXAMINER				
LLOYD, EMILY M				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
03/31/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,522

Applicant(s)

HESKE ET AL.

Examiner

EMILY M. LLOYD

Art Unit

3736

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 96-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 96-143 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group A, drawn to a vacuum pressure-generating device comprising a syringe unit having a cylindrical housing and a plunger positioned in a housing, the housing having a ventilation opening in an upper part which may be opened to dissipate a created vacuum by retraction of the plunger;

Group B, drawn to a connection element connecting an inner space of a hollow biopsy needle with an inner space of a vacuum pressure-generating device and forming an airtight connection;

Group C, drawn to a control panel connected to a plurality of actuators, with a first actuator controlling both the tension slide and the cutting sheath;

Group D, drawn to a biopsy needle unit comprising recesses that are configured to receive brackets;

Group E, drawn to a tension slide placed in a cocked position by a spindle actuator driven by a DC gear motor with single-stage secondary transmission;

Group F, drawn to a biopsy needle comprising a narrowing positioned in a lumen at a proximal end of a sample removal chamber, the narrowing being positioned at a top portion of the lumen, leaving a passage at a bottom portion of the lumen;

Group G, drawn to an opening of a sample removal chamber comprising a approximately 25% of the cross section of a biopsy needle;

Group H, drawn to a miniature switch integrated into a housing and enabling a power source;

Group I, drawn to means on a biopsy needle to prevent closing of a housing cover when a tension slide is cocked and a biopsy needle unit is installed;

Group J, drawn to surfaces on a housing for attaching a biopsy device to a positioning mechanism;

Group K, drawn to an upper outer contour of a biopsy needle unit corresponding to an inner contour of a housing;

Group L, drawn to a plastic part with knurled disk mounted by friction locking onto a proximal end of the biopsy needle;

Group M, drawn to a base block positioned in the center of a housing to support and hold components of a biopsy device;

Group N, drawn to a control panel comprising functional displays and operating switches for electronic components of a biopsy device;

Group O, drawn to a plastic part that is able to rotate with respect to a connection element and connects a connection element to a biopsy needle;

Group P, drawn to a removable element in a sterile packaged unit;

Group Q, drawn to an insert aid embracing a biopsy needle unit and a vacuum pressure-generating device along a longitudinal axis of a biopsy device;

Group R, drawn to a cutting sheath that moves approximately 2 cm beyond a distal end of a sample removal chamber when cutting a tissue sample; and

Group S, drawn to a coaxial cannula for positioning a biopsy device, including a seal to prevent vacuum from dissipating when a biopsy needle is introduced into the coaxial cannula.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Species A, claims 97-106 and 116-119;
Species B, claims 107 and 108;
Species C, claim 109;
Species D, claim 110;
Species E, claims 111-115;
Species F, claims 120-123;
Species G, claim 124;

Species H, claims 125 and 126;
Species I, claim 127;
Species J, claim 128;
Species K, claim 129;
Species L, claims 130 and 131;
Species M, claims 132-134;
Species N, claim 135;
Species O, claims 136 and 137;
Species P, claim 138;
Species Q, claims 139 and 140 (claim 140 is interpreted as depending on claim 139);
Species R, claim 141; and
Species S, claims 142 and 143.

The following claim(s) are generic: 96.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: United States Patent 4989614 (Deijter, Jr et al.) discloses a biopsy device for taking tissue samples (Figures 13-16), comprising: a housing (casing 1 Figure 13) containing an electric power source (battery 92 Column 12 lines 9-11) and a tension slide (syringe carriage 40 Figure 13) connected to the power source, wherein the tension slide is brought into a cocked position against the action of a spring (spring 61 Figure 16) by the power source; a removable element (Column 11 lines 5-7) configured for insertion into the housing, comprising: a biopsy needle unit, comprising a hollow biopsy needle (needle 2 Figure 13), having a sample removal chamber (sample storage portion 20 of needle 2 Figure 13), and a cutting sheath (sheath 6 Figure 13), wherein the biopsy needle unit is arranged on the tension slide (syringe carriage 40 Figure 13); a vacuum pressure-generating device (syringe carriage 40 and plunger support bracket 45 moving plunger 5 with respect to syringe 4, Figure 13); and a connection element connecting the biopsy needle unit and the vacuum pressure-generating device (luer-lock connections 18, 31 Figure 13 and Column 10 lines 16-18); and a control panel attached to the housing (electronic control circuit 109 Figure 13); as such, there is lack of unity a posteriori as this group of features (in Applicant's claim 96) is not a technical feature that defines a contribution over the prior art.

4. A telephone call was made to David Laub on 27 March 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY M. LLOYD whose telephone number is (571)272-2951. The examiner can normally be reached on Monday through Friday 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Emily M Lloyd
Examiner
Art Unit 3736

/EML/

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736